

REMARKS

Claims 38-47, 49-69 and 71-74 are pending. By this Amendment, claims 48 and 70 are cancelled without prejudice or surrender of the subject matter contained therein. This Amendment is proper under 37 CFR §1.116 as it merely cancels claims. Reconsideration of the remaining claims is respectfully requested based on the amendments above and the remarks below.

The Claims Satisfy the Enablement Requirement
Under 35 USC §101

The Office action rejects claims 38-65 under 35 U.S.C. § 101 stating that a “*database without associated executable code which can access the database itself can not produce useful, concrete or tangible result without associated executable code if it is non-functional descriptive material.*” Applicants respectfully traverse this rejection.

In particular, Applicants point out that they have previously satisfied the utility requirement via the specific examples of functionality of AVM databases provided in a previous Amendment. See, Cross v. Iizuku, 753 F. 2d 951, 224 USPQ 592 (Fed Cir. 1985). Further, a review of the written specification at paragraphs [0026] and [0027] shows just two of many more possible examples of function. For example, an AVM database can be used to identify all properties in a city having an AVM value between \$150,000 and \$100,000, or identify all townhouses having an AVM value between \$150,000 and \$100,000. See, Par. [0026]. Additionally, an AVM database may be used to perform a “Differential Valuation Search” (DVS) to identify properties based on both their respective AVM values and sale prices, which may allow a user to identify undervalued properties for sale in a particular region. See, Par. [0026].

Thus, Applicants have set forth several specific and substantial utilities, and have attributed “real-world” value to claimed subject matter. See, In re Fisher, 421 F.3d 1365,

1371, 76 USPQ2d 1225, 1230 (Fed. Cir. 2005), and MPEP §2107.01. These benefits show that the claimed subject matter is useful to the public as disclosed in its current form. See, Fisher at 421 F.3d at 1371, 76 USPQ2d at 1230, and MPEP §2107.01. Accordingly, the claimed subject matter has utility under 35 USC §101. Without exhausting the list of possible functions, unique services or improved services that a database of AVM values might provide, Applicants have provided more than enough examples to demonstrate that a database of AVM values can perform at least one function. **In re Gulack** (cited by the previous Office Action) requires no more. See, In re Lowry, 32 F.3d 1579 at 1584, 32 USPQ2d 1031 at 1034.

Accordingly, withdrawal of the rejection under 35 USC §101 is respectfully requested.

Claims 47, 71, 73 and 74 Comply With The Written Description Requirement Under 35 USC §112, First Paragraph

The Office Action rejects claims 47, 48, 70, 71, 73 and 74 under 35 USC §112, first paragraph, asserting that these claims fail to comply with the written description requirement. This rejection is moot regarding cancelled claims 48 and 70, and traversed with respect to claims 47, 71, 73 and 74.

In particular, Applicants point out that the feature of claim 47 “produce at least one map display that includes at least one respective AVM value associated with at least one property embedded within the map display” is supported by paragraph [0081], and further supported by paragraph [0028].

Continuing, Applicants point out that the feature of claim 71 “software downloaded onto a computer accessed by the consumer via the Internet” is supported by paragraphs [0023]-[0024] which recite that “...[t]he various links 122 and 132 of the present embodiment are a combination of devices and software/firmware configured to couple

computer-based systems to the Internet over a wired line,” {bolded emphases added} and that “the provider 130 of the present embodiment can provide a number of web-pages formatted using HTML, XML, Flash or any other viable publishing standard, such that users accessing the web-pages can do so using nothing more than a commercially available web-browser.” As HTML and Flash are both software standards usable over the Internet and known to be provided by servers, Applicants respectfully assert that claim 71 is supported by the written specification.

Similarly, Applicants assert that the language of claims 73 and 74 are supported by paragraphs [0023]-[0024] recited above.

Accordingly, Applicants respectfully request withdrawal of the rejection of claims 47, 71, 73 and 74 under 35 USC §112, first paragraph.

**Claims 38-65 Comply With Both The Enablement and Written Requirements
Under 35 USC §112, First Paragraph**

The Office Action rejects claims 38-65 under 35 USC §112, first paragraph, asserting that these claims fail to comply with the written description requirement stating that: (1) “Applicant has not disclosed how a database that holds the data enables the computer to perform a query,” and that (2) “a computer can perform a query irregardless of whether the database consists of data or it is empty.” This rejection is respectfully traversed.

As an initial issue, Applicants respectfully point out that the function of the written description requirement is to ensure that the inventors had possession at the filing date of the application of the claimed subject matter later claimed by the inventors. However, the statements made by the Office Action are more consistent with issues regarding the enablement requirement of 35 USC §112, first paragraph, which becomes especially clear given that the Office Action has already addressed the written requirement of 35 USC §112,

first paragraph, in the previous rejection. Additionally, it is clear that the remaining claims are well supported. For example, claim 38 is fully supported by (now cancelled) claim 1, and can be differentiated in that language incorporated in the preamble of claim 1 is incorporated into the body of the claim 38. Accordingly, as the Office Action has made no assertion that specific features are not disclosed, Applicants will address the specific statements made by the Office Action.

Regarding statement (1), the enablement requirement requires a determination of whether the present application, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed subject matter. See, MPEP §2164.01. It is not necessary for the written description to describe every detail of a particular machine, but merely to enable one of ordinary skill in the art to make and use the claimed device. See, MPEP §2164. The present disclosure must be held sufficient if it would enable a person skilled in the computer art to make and use the claimed subject matter. See, Ex parte Zechall, 194 USPQ 461 (Bd. App. 1973), 194 USPQ at 461, and MPEP §2164.05(b). The specification need not disclose what is well-known to those skilled in the art and preferably omits that which is well-known to those skilled and already available to the public. In re Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). See also, MPEP §2164.05(a)

In the present circumstances, Applicants assert that query devices are well known. Literally thousands of text books devoted to the subject have been written. Additionally, Applicants again point out that the Federal Circuit has recognized that query devices are well known. For example, the underlying disclosure of Lowry (United States Patent No.

5,664,177) does not describe any details about the construction of a machine capable of performing a query, and the Federal Circuit made no such requirement that it should. Additionally, Applicants note that USPTO Examiners are often required to perform queries on USPTO and other databases.

Accordingly, as queries and query technology are well-known to those skilled in the arts and already available to the public, the inclusion of such information in the present specification is not only not necessary, but specifically disfavored by the Federal Circuit. See, In re Buchner.

Regarding statement (2), Applicants respectfully assert point out that a query is a mechanism for retrieving information from a database. Accordingly, an empty database containing no information cannot be queried. Certainly, an empty database containing no information cannot be used to perform an AVM-related query.

Respectfully, Applicants wish to point out that the present rejection under 35 USC §112, ¶ 1, appears to be a repetition of an issue settled in the previous Office Action and Response, whereby the previous Office Action did not want to give the term “AVM value” patentable weight, but where Applicants were assured by SPE Weiss that patentable weight would be assured after multiple negotiations on claim language.

Applicants respectfully note that, at the time of the last Office Action, Applicants made a voluntary amendment to the independent claims despite the fact that the USPTO failed to provide a single iota of authority to support the Patent Office’s claim that terms in a database needed functional language to confer patentable weight. Accordingly, should the USPTO re-affirm the present rejection or any rejection whereby data in an AVM database is equated with a database containing no information whatsoever, Applicants respectfully ask the Examiner to provide legal authority both in controlling case law and from the MPEP to support the need for functional language to confirm patentable weight, as well as to provide

legal authority both in controlling case law and from the MPEP allowing the USPTO to disregard data in a database.

Thus, Applicants respectfully request withdrawal of the rejection of claims 38-65 under 35 USC §112, first paragraph.

**The Claims are Directed to
Patentable Subject Matter Under 35 USC §103(a)**

The Office Action rejects claims 38-45, 49-65 and 68-74 under 35 USC §103(a) over Metropolitan Regional Information, Inc (hereinafter "MRIS") in view of a March 2004 article entitled "Here's How to Calculate Home Value" by Holden Lewis (hereinafter "Lewis"); rejects claims 46-48 under 35 USC §103(a) over MRIS in view of Lewis and Du (United States Pat. No 6,836,270); and rejects claims 66-67 under 35 USC §103(a) over an April 2004 article about Fairfax County Property Assessment (hereinafter "FCPA") in view of an article entitled "Appraisers Learning to Live With Black Box Technology" by Lawrence Quinn (hereinafter "Quinn").

These rejections are moot in view of an accompanying Declaration under 37 CFR §1.131 (with Exhibit and Attachment), which places the date of invention before the March 2004 publication date of the Lewis article as well as before the April 2006 publication date of the FCPA article. Accordingly, as the Lewis and FCPA articles may no longer be applied to any of claims 38-74, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. §103(a).

Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly

solicited. Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is welcomed to contact the undersigned attorney at the below-listed number and address.

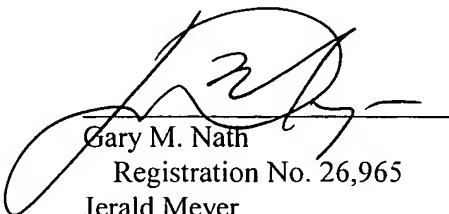
In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Gary M. Nath', is written over a horizontal line.

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